REMARKS

In this non-final Office Action, claims 1-16 are pending, of which claims 1-16 stand rejected. By this amendment, claim 13 has been amended to correct a typographical error and all other claims continue unamended. Arguments addressing the Examiner's position are provided. In view of both the amendments presented above and the following discussion, the applicants submit that none of the claims now pending in the application are anticipated or obvious under the provisions of 35 U.S.C. §102 and 35 U.S.C. §103. Thus, the applicants believe that all of these claims are now in allowable form.

It is to be understood that the applicants, by amending the claims, do not acquiesce to the Examiner's characterizations of the art of record or to applicants' subject matter recited in the pending claims. Further, applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant responsive amendments.

REJECTION OF CLAIMS UNDER 35 U.S.C. §102

Claims 1, 3-4, 6, and 15-16

The Examiner has rejected claims 1, 3-4, 6, and 15-16 as being anticipated by Brown et al. (U.S. Patent 5,802,448, hereinafter "Brown"). Applicants respectfully traverse the rejection.

Specifically, with respect to claim 1, the Examiner alleges that Brown teaches the claimed method for delivering short-time duration video segments to terminals via communications network as seen In Figures 1, 3 and 4 and column 3, lines 9-60 of the reference. Additionally, the Examiner offers that a user may transmit a request which is received from a terminal corresponding to a selected object and processed by a session manager 410. This processing includes determination of adequate bandwidth to transmit the desired object (column 5, lines 12-16). The Examiner also alleges that as per step 525 of FIG. 5, if a timer has expired, the connection is terminated at step 530 thereby meeting the claimed generation of a control message Indicating whether a transport stream may be discontinued ... to release bandwidth. This activity allegedly

frees up resources from an oldest transport stream needed for delivery, and allows network interface 425 to determine if sufficient bandwidth is available according to the mathematical relationship denoted at column 5, lines 18-55. More specifically, the Examiner clarifies that when the timer has expired, a transport stream is the "oldest" and the corresponding bandwidth is released (column 5, lines 46-51, column 6, lines 28-29, and column 7, lines 28-30). Additionally, the Examiner offers a network diagram of FIG. 3 which is described in detail with reference to the corresponding FIG. 2 of U.S. Patent No. 5,819,036 to Adams which is incorporated by reference in Brown to show multiplexing of transport streams and the sharing of a physical link of the same.

In response, Applicants respectfully traverse the rejection. Case law cited in Applicants' earlier response is of record. It is respectfully submitted that the cited art does not teach, disclose or suggest the subject invention. Brown merely makes a determination of resource constraint and sends appropriate presentations based on the constraint determination. That is, if the constraint indicates sufficient bandwidth, a first (more complex) presentation (i.e., video) is transmitted. If the constraint indicates insufficient bandwidth, a second (simpler) presentation (i.e., a still picture) is transmitted. The fundamental flaw in the Examiner's reasoning (at the bottom of Page 2 in the "Response to Amendment" section and top of Page 4 in the "Claim Rejections" section) is that when the timer of Brown expires in step 525, there is an assertion that the released bandwidth is bandwidth that was taken up by transport streams older than the presentation (or requested video segment as claimed). The Examiner's assertion is erroneous because if any bandwidth is released (this point is still not specifically clarified in the reference) it is bandwidth that would be taken up by the new stream that was requested by the viewer (i.e., either the first or second presentations identified at either Col 4, lines 60-67 or Col 5, lines 58-65) that was incorporated into a multiplexed stream. Applicant redirects the Examiner to the third element of claim 1,

> "transmitting a control message from the session manager to a transport stream generator, said control message indicating whether one of the oldest transport streams of said multiplexed transport stream may be discontinued by said transport stream generator to release bandwidth, said transport stream generator transmitting said video segment if sufficient bandwidth is available, said transmitted video segment adapted for presentation at said requesting terminal and including a beginning portion of said video segment."

The claimed invention recites existing older transport streams that are discontinued to release bandwidth, not the requested stream as taught in Brown.

In other words, the Examiner is interpreting the steps of Brown incorrectly so as to read on the subject invention. As stated earlier, the sole criteria for Brown to send a transmission is determining how much bandwidth is available (by virtue of the cited formula at Col 5, lines 16-26). The reference does not look at the age of transport streams (or other presentations) in the multiplexed transport stream prior to the decision of which presentation (the first/video one or the second/still one) to send. Additionally, after the appropriate transmission is timed out, the reference only provides that the method terminates (there is no teaching of subsequently releasing bandwidth). Therefore the Examiner has attempted to disassemble and reshuffle the specific ordered steps of Brown and piece them together to read upon the subject invention. Such alleged evidence to support anticipation is not permitted because it does not put the claimed invention in the hand of one skilled in the art. The subject invention clearly claims that if sufficient bandwidth is available by the releasing of older streams (NOT the new, requested stream), said requested video segment is transmitted.

Therefore, it is respectfully submitted that claim 1 as it presently stands is allowable in view of Brown and patentable under the anticipation statute.

Additionally, claims 3-4, 6 and 15-16 depend, either directly or indirectly, from claim 1 and recite additional features of the invention. As such, and for at least the same reasons discussed with respect to Claim 1, it is respectfully submitted that these dependent claims are also allowable in view of Brown and patentable under the statute.

REJECTION OF CLAIMS UNDER 35 U.S.C. §103

A. Claim 2

The Examiner has rejected claim 2 under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Girard et al. (U.S. Patent No. 5,751,282, hereinafter "Girard"). The Applicants respectfully traverse the rejection.

Applicants' explanation of Brown with respect to the §102 rejection is also applicable with respect to the §103 rejection herein. As such, and for brevity, that explanation will not be repeated in as great detail. As indicated, Brown does not teach or suggest the step of transmitting a control message from a session manager to a transport stream generator, said control message indicating whether a transport stream may be discontinued by said transport stream generator to release bandwidth as recited in Applicants' claim 1. Because Applicants' claim 2 depends from claim 1, claim 2 also contains the features (the features of claim 1) not taught or suggested by Brown.

The addition of Girard does not correct the deficiencies of Brown. Girard teaches a system and method for calling video on demand using an electronic programming guide. The Examiner specifically indicates that Brown does not teach that video segments are "delivered as part of an interactive program guide" and offers that Girard teaches video segments transmitted in a program guide as seen with reference to Figure 2 which shown a preview of clipped region 58. Accordingly, the Examiner concludes that it would have been obvious for one skilled in the art at the time of the subject invention to modify the method of Brown by transmitting requested video segments as part of a program guide in order to preview clips that assist a user chooses a program.

In response, it is respectfully submitted that the combination of Brown and Girard as a whole still does not teach of suggest the subject invention. Brown has been shown to be defective in not reciting the specific method steps of the claimed invention and Girard is used only to disclose video segments transmitted within the program guide. The combination of Brown and Girard results in an interactive communication system that displays video segments in a program guide and performs network

resource (or bandwidth) limitations without having a session manager send a control message to a transport stream generator in the manner claimed. As discussed earlier in the prosecution history, Girard is silent with respect to the "transmission of a control message from the session manager to a transport stream generator, where the control message causes the transport stream generator to discontinue a transport stream and to release bandwidth so that another transport stream may be transmitted by the transport stream generator, as recited in Applicants' claim 1.

For prior art references to be combined to render obvious a subsequent invention under 35 U.S.C. §103, there must be something in the prior art as a whole which suggests the desirability, and thus the obviousness, of making the combination. Uniroyal v. Rudkin-Wiley, 5 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988). Moreover, the mere fact that a prior art structure could be modified to produce the claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992); In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). Nowhere in the combination of references is there any teaching, suggestion, or incentive to include a control message sent from the session manager to the transport stream generator which allocates available bandwidth. Therefore, the combined references fail to teach the Applicants' invention as a whole. As such, the applicants submit that claim 2 (at least for its dependency upon non-obvious independent claim 1) is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Therefore, the Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. §103 rejection.

B. Claims 5

The Examiner has rejected claim 5 under 35 U.S.C. §103(a) as being unpatentable over Brown in view of U.S. Patent 5,559,549 ("Hendricks"). Applicants respectfully traverse the rejection.

Applicants' explanation of Brown with respect to the §102 rejection is also applicable with respect to the §103 rejection herein. As such, and for brevity, that

explanation will not be repeated in as great detail. As indicated, Brown does not teach or suggest the step of transmitting a control message from a session manager to a transport stream generator, said control message indicating whether a transport stream may be discontinued by said transport stream generator to release bandwidth as recited in Applicants' claim 1. Because Applicants' claim 5 depends from claim 1, claim 5 also contains the features (the features of claim 1) not taught or suggested by Brown.

The addition of Hendricks does not correct the deficiencies of Brown. Hendricks discloses a digital television program delivery system that provides subscribers with a menu-driven access to an expanded television program package. The system allows for a number of television signals to be transmitted by using digital compression techniques. However, Hendricks is silent with respect to the transmission of a control message by the session control manager, as recited in Applicants' claim 1.

As discussed in Section A of this obviousness argument, for prior art references to be combined to render obvious a subsequent invention under 35 U.S.C. §103, there must be something in the prior art as a whole which suggests the desirability, and thus the obviousness, of making the combination. Nowhere in the combination of references is there any teaching, suggestion, or incentive to include a control message sent from the session manager to the transport stream generator which allocates available bandwidth. Therefore, the combined references fail to teach the Applicants' invention as a whole. As such, the applicants submit that claim 5 (at least for its dependency upon non-obvious independent claim 1) is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Therefore, the Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. §103 rejection.

C. Claims 7 and 8

The Examiner has rejected claims 7 and 8 under 35 U.S.C. §103(a) as being unpatentable over Brown. Applicants respectfully traverse the rejection.

Applicants' explanation of Brown with respect to the §102 rejection is also applicable in this section. As such, and for brevity, those comments will not be

repeated. As indicated above, Brown does not teach or suggest Applicants' claim 1. In addition Applicants' claims 7 and 8 depend (either directly or indirectly) from claim 1 and recite additional features of the invention. The Examiner had previously (in the June 5, 2003 Office Action) taken Official Notice that it is well known in the art to transmit an upstream release message from a terminal to a headend in accordance with claim 7, and tracking by the session manager of video segments being acquired by at least one terminal in accordance with claim 8. The Examiner, in his Final Office Action, then indicates that since Applicants had failed to adequately traverse the Official Notice of the June 5, 2003 Office Action, these statements are taken as admitted prior art per M.P.E.P. 2144.03(c). For the sake of clarity, Applicants note that per M.P.E.P. 2144.03(b), "(T)he Examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 U.S.P.Q. at 801; *Chevenard*, 139 F.2d at 713, 60 U.S.P.Q. at 241. The applicant should be presented with the explicit basis on which the Examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made." Since the Examiner had not provided any explicit basis for his conclusion of common knowledge with respect to these particular aspects of the invention, there was in fact no Official Notice taken to be properly traversed. As such, the statements should not now be taken as official knowledge or prior art at this time.

Notwithstanding dispensation of the Examiner's comments regarding Official Notice, it is respectfully submitted that these additional features (that are alleged prior art) still do not, as a whole, when combined with the teachings of Brown teach or suggest Applicants' invention. That is, Brown in combination with the alleged Official Notice information still does not properly suggest the step of generating a control message by a session manager in the manner claimed. Applicants respectfully submit that at least for the reasons presented above, claims 7 and 8 are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. §103 rejection.

D. **Claims 9-14**

The Examiner has rejected claims 9-14 under 35 U.S.C. §103(a) as being unpatentable over Brown in view of Aharoni et al. U.S. Patent No. 6,014,694 (Aharoni). Applicants respectfully traverse the rejection.

Applicants' explanation of Brown with respect to the §102 rejection is also applicable in this section. As such, and for brevity, those comments will not be repeated. The addition of Aharoni does not correct the deficiencies of Brown. Aharoni discloses transporting video over networks wherein the available bandwidth varies with time. Specifically,

> [t]he system comprises a video/audio codec that functions to compress, code, decode and decompress video streams that are transmitted over networks having available bandwidths that vary with time and location. Depending on channel bandwidth, the system adjusts the compression ratio to accommodate a plurality of bandwidths ranging from 20 Kbps for POTS to several Mbps for switched LAN and ATM environments. See Aharoni Abstract.

Additionally, the Examiner provides alleged support in Aharoni for the various dependent features recited in claims 9-14; however, Aharoni is also silent with respect to the transmission of a control message from the session manager, as recited in Applicants' claim 1. Nowhere in the combination of references is there any teaching, suggestion, or incentive to include a control message from the session manager to the transport stream generator indicating whether a "transport stream may be discontinued by the transport stream generator to release bandwidth ...," as recited by the Applicants.

Therefore, the combined references fail to teach the Applicants' invention as a whole. As indicated above, Brown or Aharoni do not render Applicants' claim 1 obvious. In addition Applicants' claims 9-14 depend (either directly or indirectly) from claim 1 and recite additional features therefore. As such, the Applicants submit that claims 9-14 are not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicants respectfully request that the rejection be withdrawn.

CONCLUSION

Thus, the Applicants submit that all the claims presently in the application are in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited. If at any point during the prosecution the Examiner believes a telephone call would assist in resolving one or more of the issues brought forth during the prosecution history, Applicants are open to discussion of these issues and requests Agent Joseph Pagnotta or Eamon J. Wall, Esq. be contacted at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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